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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,140	11/04/2003	Tongbi Jiang	303.343US9	4829

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EXAMINER	
LAMB, BRENDA A	

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/701,140	JIANG ET AL.	
	Examiner	Art Unit	
	Brenda A Lamb	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) *5-7* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/08/03 and* 11/04/2003
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4, drawn to stencil, classified in class 118, subclass 504.

II. Claims 5-6, drawn to method for manufacturing a stencil, classified in class 101, subclass 128.21.

III. Claim 7 is, drawn to method for using a stencil, classified in class 427, subclass 282.

The inventions are distinct, each from the other because:

Inventions III and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the stencil as claimed can be used in a materially different process such as one wherein the printable material is spread across the surface of stencil having a coating exhibiting a surface tension less then the surface tension of the stencil pattern.

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the stencil as claimed can be made by a materially different process such as one wherein a sheet of material impervious to the printed material is coated on the top surface of the sheet of material with a first coating

having properties within scope of the claim and coated on the bottom surface of the sheet of material with a second coating having properties within scope of the claim, thereafter the pattern of stenciling opening is formed by punching the material and finally the one or more side surfaces of the stenciling openings is coated with the first coating.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions in that the process of Group II is directed to a process for manufacturing the stencil wherein the process of Group III is directed to a method for using stencil. The stencil of Group II may used in a materially different process such as one for using a photomask.

During a telephone conversation with Attorney Clise on 1/7/05 a provisional election was with traverse to prosecute the invention of Group I, claims 1-4. Applicant in replying to this Office action must make affirmation of this election. Claims 5-7 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 47-53, 58-64, 69-73 of U.S. Patent No. 6,669,781 (Jiang et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because Jiang et al claims the design of a stencil comprised of a sheet of metal or metal alloy material having a plurality of apertures so as to define a desired pattern thereby reading on applicant's claimed stencil pattern; a first coating applied to a surface of the sheet of material with apertures/stencil pattern and to side surfaces of the stencil openings or apertures; a second coating applied to the opposite surface of the stencil pattern. Jiang et al claims the sheet of material or stencil pattern is stainless steel pattern such as set forth in instant claim 2. Jiang et al first coating is selected from the group of materials such as set forth in instant claim 3. Jiang et al's claims the first coating is a polymeric material such as set forth in instant claim 4. Therefore, the recitation in instant claim 1 that applicant's claimed first coating has a surface tension greater than surface tension of the stencil pattern and applicant's

claimed second coating has a surface tension less than the surface tension of the stencil pattern does not define applicant's invention over Jiang et al since Jiang et al material of construction for the stencil pattern, first coating and second coating reads on that claimed by applicant.

Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-15 of U.S. Patent No. 6,599,365 (Jiang et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because Jiang et al claims the design of a stencil comprised of a sheet of metal or metal alloy material having a plurality of apertures so as to define a desired pattern thereby reading on applicant's claimed stencil pattern; a first coating applied to a surface of the sheet of material with apertures/stencil pattern and to side surfaces of the stencil openings or apertures; a second coating applied to the opposite surface of the stencil pattern. Jiang et al claims the sheet of material or stencil pattern is stainless steel pattern such as set forth in instant claim 2. Jiang et al claims the first coating having a surface tension to promote spreading of the printable material. Jiang et al claims the first coating is selected from the group of materials such as set forth in instant claim 3. Therefore, the recitation in instant claim 1 that applicant's claimed first coating has a surface tension greater than surface tension of the stencil pattern does not define applicant's invention over Jiang et al since Jiang et al material of construction for the stencil pattern and first coating reads on that claimed by applicant. Further, Jiang et al's claims the first coating having a surface tension to retard spreading of the printable material thereby has a surface tension less than the stencil pattern.

Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-24 of U.S. Patent No. 6,641,669 (Jiang et al) in view of Hefele.

Jiang et al claims the design of a stencil/screen comprised of a first patterned layer of stainless steel; a second polymeric patterned layer disposed underneath the first patterned layer having a surface tension relative to the first patterned layer such that it reads on the applicant's second coating; and a third patterned layer disposed over the first patterned layer having a surface tension relative to the first patterned layer such that it reads on applicant's first coating. Jiang et al fails to teach that the stencil has at least one opening and the first coating on one or more side surfaces of the at least one opening. However, it would have been obvious to modify the Jiang et al stencil/screen by providing at least one opening and the side surfaces of the opening would have the first coating since stencil/screens are known to have opening and openings are known to have coating similar to that provided such as shown by Hefele for increased wear resistance of those surfaces in direct contact with coating.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday and Wednesday thru Friday with alternate Tuesdays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brenda A. Lamb

BRENDA A. LAMB
PRIMARY EXAMINER

Lamb/LR
January 27, 2005